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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,004	06/04/2001	Hisashi Tanaka	NEC01P071-S1b	3637
30743	7590	12/01/2004	EXAMINER	
WHITHAM, CURTIS & CHRISTOFFERSON, P.C. 11491 SUNSET HILLS ROAD SUITE 340 RESTON, VA 20190			HAQ, NAEEM U	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/872,004

Applicant(s)

TANAKA ET AL.

Examiner

Naeem Haq

Art Unit

3625

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —  
Period for Reply

## A. SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_

- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

***Response to Amendment***

This action is in response to the Applicants' amendment filed on September 14, 2004. Claims 1-7 are pending and will be considered for examination.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 5 and 6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The limitation "...for enabling..." is merely one of intended use and does not explicitly mean that the program is embodied on a computer medium. Therefore claims 5 and 6 are deemed to be non-statutory subject matter as per MPEP 2106.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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**Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by**

**Kondoh et al (US 2001/0011239 A1) hereinafter referred to as Kondoh.**

Referring to claim 1, Kondoh teaches a network marketing system, method, computer program, and sever comprising:

- at least one user terminal for being operated by a user that purchases items and having the capability to be connected to a network (Figure 1, items "11" and "12"; ¶ [0046] and [0052]);
- an item database for storing information on items on the market Figure 1, "85"; ¶ [0050]);
- a shopping cart database each associated with each user for storing shopping carts to temporarily save items to be investigated for purchase by a user (Figure 1, "84"; ¶ [0049]); and
- a marketer server connected to said network, for providing said user terminal with item information stored in said item database (Figure 1, item "2"; ¶ [0052]), for adding a particular item to a shopping cart stored in said shopping cart database upon receiving notification from said user terminal to add that item to the shopping cart (¶ [0049]; Figure 2, steps 111-116), for sequentially presenting items in said shopping cart to said user terminal to confirm whether or not the user has the intention to purchase upon receiving notification from said user terminal of the intention to purchase items in the shopping cart (Figure 7), and for actually accepting

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an application to purchase only with respect to items for which intention of an application to purchase could be confirmed (Figure 7);

- wherein said user terminal establishes a right to purchase preferentially a particular item when said user saves the item in said shopping cart ([0218]).

### ***Response to Arguments***

Applicant's arguments with respect to the Alloul reference have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments with respect to the Kondoh reference have been fully considered but they are not persuasive. The Applicants have argued that Kondoh does not teach sequentially presenting items in the shopping cart but rather a list of items. The Examiner respectfully disagrees. Merriam-Webster's Collegiate Dictionary, tenth edition, defines sequentially as "an order of succession". Kondoh teaches an order of succession of items in the shopping cart (Figure 7). The Applicants have pointed to Figures 6A and 6B of their specification to define the limitation "sequentially presenting items..." however, this is merely one example of the limitation and does not exclude other sequential presentations.

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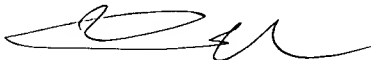
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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on (703)-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Naeem Haq**, Patent Examiner  
Art Unit 3625

November 27, 2004



**WYNN W. COGGINS**  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600